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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/078,808 | 02/19/2002 | Manas Kumar Majumdar | 08702.0086-00000 | 7146 |

7590 09/29/2004

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EXAMINER

ANDRES, JANET L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1646

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/078,808

Applicant(s)

MAJUMDAR ET AL.

Examiner

Janet L. Andres

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 21, 23-31.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


JANET ANDRES
PRIMARY EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection of claims 11 and 12 under 35 U.S.C. 102(a) and 102(e) as well as under 35 U.S.C. 112, second paragraph, is overcome by Applicant's cancellation of these claims. The rejection of claims 21 and 23-31 under 102(a) as anticipated by WO 00/29552 is overcome by Applicant's amendment requiring single-step purification as is the corresponding rejection of the claims under 35 U.S. 103(a).

Continuation of 5. does NOT place the application in condition for allowance because: Applicant has amended the claims to require single-step purification of non-expanded cells. Applicant argues that WO 00/29552 does not teach this means of purification. While this argument is sufficient to overcome the rejection of these claims under 102(a), they would be newly rejected under 35 U.S.C. 103(a) because single step purification is merely an art-standard modification of two-step purification. The means for such modification are well known and commercially available. Applicant's arguments with respect to the fact that neither WO 00/29552 nor the '816 patent exemplify non-expanded cells are not persuasive. WO 00/29552 gives clear guidance as to how to purify and use a non-expanded population; actual working examples are not required for an enabling disclosure. Further, U.S. patent 6,761,887, which issued from the national stage application of WO 00/29552, claims MSC compositions for this use and clearly states in column 5 that such cells may be non-expanded and antibody purified. The claims of an issued U.S. patent are considered to be enabled.